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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/722,737

11/25/2003

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01/13/2009

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EXAMINER

ARNOLD, ERNST V

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/722,737	Applicant(s) GALER, BRADLEY S.	
	Examiner ERNST V. ARNOLD	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The finality of the prior Office Action is withdrawn. The current Examiner of record has a new ground of rejection.

Claims 1-11 are pending and under examination.

Withdrawn rejections:

Applicant's amendments and arguments filed 11/3/08 are acknowledged and have been fully considered. Any rejection and/or objection not specifically addressed below is herein withdrawn. The current Examiner of record is withdrawing the prior rejections in favor of the rejections below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hind (US 5411738) as evidenced by MedlinePlus Medical Encyclopedia: Neuralgia.

Hind discloses methods for treating nerve injury such as post-herpetic neuralgia with topical application of lidocaine to the skin at the site of the pain (Abstract and claims 1-8). As evidenced by MedlinePlus Medical Encyclopedia: Neuralgia, which is

Art Unit: 1616

also known as postherpetic neuralgia, the symptoms include pain and **numbness** of the affected skin area (See symptoms pages 1-2 of 4). Numbness is a neuropathically-induced negative sensory phenomena (See [0011] pages 3-4 of the instant specification). Therefore, the method of Hind inherently treats any neuropathically-induced negative sensory phenomena, such as numbness, because it is a symptom and associated with the disorder and instant claims 1-4 are anticipated. Hind discloses applying a patch which anticipates instant claim 5 (claims 2-6). Hind discloses from about 1-20% lidocaine which anticipates instant claim 6 and 7 (claim 5). Hind discloses a lidocaine patch with a non-woven polyester backing which anticipates instant claim 8 (column 15, lines 11-16 and claim 3). Hind discloses a method in column 15, lines 11-26:

Study Drug and Placebo

Lidocaine patches (Lidoderm Patch) contain an adhesive of 5% lidocaine base (700 mg/patch), water, glycerin, D-sorbitol, sodium polyacrylate, sodium carboxymethylcellulose, propylene glycol and other ingredients on a non-woven polyester backing. Vehicle placebo patches are identical except for the absence of lidocaine. The size of a single patch is 10×14 cm.

Patch Application

Prior to patch application, the painful area to be treated was marked and then photographed based on the subject's report of (1) the borders of the area of sensory abnormality, and (2) the area of greatest pain. Up to 3 patches were applied to cover the area of greatest pain as fully as possible within the limit of 420 cm² of patch area.

Since 'backing' is being interpreted to mean a cover and any numbness is inherently treated by the method then instant claims 9-11 are anticipated.

Art Unit: 1616

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hind (US 5411738 (IDS filed on 4/30/04) in view of Wolicki (US 2004/0101582) as evidenced by MedlinePlus Medical Encyclopedia: Neuralgia.

Applicant claims a method for treating neuropathically-induced negative sensory phenomena comprising applying an anesthetic topically to the skin of a patient suffering from neuropathic negative sensory phenomena at or near the locus of the negative sensory phenomena.

Determination of the scope and content of the prior art

(MPEP 2141.01)

Art Unit: 1616

The references of Hind and MedlinePlus are discussed in detail above and those discussions are hereby incorporated by reference.

Wolicki teaches in claim 6 the equivalence of various benzoic acid derivatives for the treatment of neuropathy:

- 5 6. The topical composition of claim 2, wherein said additional ingredient is selected from the group consisting of: capsaicin, lidocaine, bupivacaine, mepivacaine, ropivacaine, tetracaine, etidocaine, chlorprocaine, prilocaine, procaine, benzocaine, dibucaine, dyclonine hydrochloride, pramoxine hydrochloride, benzocaine, and proparacaine.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

1. The difference between the instant application and Hind is that Hind do not expressly teach various benzoic acid derivatives in the method. This deficiency in Hind is cured by the teachings of Wolicki.

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

1. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add other benzoic acid derivatives, as suggested by Wolicki, to the method of Hind and produce the instant invention.

Art Unit: 1616

One of ordinary skill in the art would have been motivated to do this because the art teaches the benzoic acid derivatives to be equivalent in methods of treating neuropathy. The expected result remains treatment of the neuropathy.

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernst V. Arnold whose telephone number is 571-272-8509. The examiner can normally be reached on M-F (7:15 am-4:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Ernst V Arnold/
Examiner, Art Unit 1616